

Remarks

## 35 U.S.C. § 103 Rejection of Claims

In the 1 July 2005 Office Action, claims 36 - 70 are rejected as being unpatentable over Marshall (US Patent 6,073,115) in view of Tull, Jr. (U.S. Patent 6,092,056).

The Assignee respectfully traverses the §103 rejections of claims 36 - 70 in four ways. First, by noting that the Office Action cites a combination of references that teaches away from the proposed combination. Second, by noting that the cited combination of references fails to establish a prima facie case of obviousness. Third, by noting that the cited combination of references fails to make the invention as a whole obvious. Fourth, by noting that the office action does not teach how the cited references could be combined to produce anything useful. The Assignee also notes that there are still other ways in which all §103 obviousness rejections in the 1 July 2005 Office Action for claims 36 - 70 can be traversed.

MPEP § 2145 X.D.2 provides that: "it is improper to combine references where the references teach away from their combination." Tull Jr. teaches the use beta for risk analysis (Column 7, Lines 37 - 38) and that security prices move with the market (Column 11, Lines 20 - 25, Column 12, lines 28 - 35). Both of these teachings are tenets of the Efficient Market Theory. At the same time, Marshall teaches away from the Efficient Market Theory by teaching that the dynamics of security price changes can be understood by analyzing changes in technical factors, fundamental factors and/or derivatives (Column 7, Lines 39 - 56) using a virtual reality system. It clearly would be improper to combine an invention for managing security portfolios in accordance with the Efficient Market Theory (Tull Jr.) with an invention that teaches away from the Efficient Market Theory (Marshall). In short, Tull Jr. and Marshall teach away from their proposed combination.

As discussed previously, the 1 July 2005 Office Action fails to establish the prima facie case of obviousness required to sustain the rejections of claim 36 - 70. MPEP 2142 provides that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. As detailed below, the 1 July 2005 Office Action fails to

meet all three of the criteria for establishing a prima facie case of obviousness for claims 36 - 70.

The 1 July 2005 Office Action fails to meet the first criteria for establishing a prima facie case of obviousness for claims 36 - 70 because the two references (Marshall and Tull Jr.) teach away from the theoretical combination contained in the Office Action. It is well established that "teachings of references can be combined only if there is some suggestion or incentive to do so" quoting ACS Hosp. Sys., Inc. v Montefiore Hosp., 732 F.2d 1572, 1577 221 U.S.P.Q 929,933 (Fed. Cir. 1984). One of the primary functions of the system described by Tull Jr. is to manage securities in accordance with the teachings of the Efficient Market Theory (Tull Jr., Abstract). At the same time, the Marshall invention was created to help exploit inefficiencies in the market by dynamically visualizing how changes in technical factors, fundamental factors and/or derivatives affect stock price changes over time (Column 7, Lines 39 - 56). As a result, there is an incentive not to make the combination as the two diametrically opposed views of security pricing and the stock market contained in the cited combination could not be used to support the development of a coherent view of security trading and/or portfolio management.

In the 1 July 2005 Office Action the Examiner claims that the cited portions of the references and logic provide motivation for the cited combination. The Assignee respectfully submits that the cited portions of the references do not provide sufficient motivation to overcome the fact that the references teach away from the proposed combination. However, if the Examiner has personal knowledge that supports the cited combination, then the Assignee requests that an affidavit be provided that details said knowledge in accordance with the provisions of 37 CFR 1.104.

The 1 July 2005 Office Action fails to meet the second criteria for establishing a prima facie case of obviousness for claims 36 - 70 because it does not cite a combination of teachings that has a reasonable expectation of success. There are at least two reasons why the cited combination of reference does not have a reasonable expectation of success.

The first reason the combination would be expected to fail is that the cited references teach two diametrically opposed views of security pricing and stock market dynamics. As a result, the combination could not be used to support the development and/or use of a coherent view of security trading, portfolio management and/or anything else.

Serial No. 09/764,068

3

Examiner: Clement Graham  
Art Unit: 3628

The second reason the combination would be expected to fail is that the completion of the processing for the independent and dependent claims requires the use of a series of data processing and analytical steps that are new, novel and/or non-obvious. The claimed invention relies on a number of methods, systems and/or media also disclosed in one or more cross-referenced applications. The prosecution to date of these cross-referenced patent applications has documented the fact that there are well over forty (40) instances of novelty, non obviousness and/or newness relative to the state of the art that are incorporated in the methods, media and/or systems utilized in the claimed invention. The evidence of novelty, non-obviousness and/or newness relative to the state of the art was established in a variety of ways including: a documented inability to produce similar results, a teaching away from claimed methods, a documented failure to recognize the problem and/or a teaching away from claimed combinations. The table below identifies the references that Examiners for cross referenced applications have used to document the state of the art. This documentation has in turn generated a substantial body of evidence that documents the novelty, newness and non-obviousness of the claimed invention.

Fields that have provided evidence of novelty, non-obviousness and/or newness	Cited References	Applications
Data Processing	Bowman-Amuah, Lyons, Marshall, Subramanian et al	09/764,068, 09/940,450, 10/282,113
Financial Analysis/Management	Agpar, Bielinski, Brown, Harhen, Lyons, Marshall, Reilly, USPAP	08/999,245, 09/761,671, 09/764,068, 10/282,113
Portfolio Management/ Security Analysis	Atkins, Kant, Marshall Sandretto, Tull Jr.	09/293,336, 09/764,068

In order to have a reasonable chance of success, the cited combination of references would have to identify shortcomings in the documented state of the art and/or teach the new, novel and/or non-obvious methods disclosed in one or more cross-referenced applications. The 1 July 2005 Office Action fails to provide the required teachings. In some cases, the cited references re-enforce the previously documented state of the art. Even more telling, the cited combination of references documents additional instances of the novelty, non-obviousness and/or newness of the claimed invention (pushing the total to well over 50 - note: multiple references for the same instance are counted multiple times).

Serial No. 09/764,068

4

Examiner: Clement Graham  
Art Unit: 3628

In short, the second reason the cited combination would be expected to fail is because completion of the required processing requires a substantial advance relative to the state of the art that has been defined by the Examiners of cross referenced applications and the cited combination of references fails to teach the required advances while documenting additional instances of novelty, newness and/or non-obviousness in the claimed invention.

Summarizing the above discussion, the orthogonal teachings of the cited references and a substantial body of evidence developed by the Examiners of cross-referenced applications (and the current application) provides convincing proof that the cited combination is an almost certain failure not a probable success. The Assignee notes that there are still other ways in which the absence of a reasonable expectation of success for the cited combination can be documented.

The 1 July 2005 Office Action fails to meet the third criteria for establishing a prima facie case of obviousness because it does not teach or suggest one or more limitations for every claim.

Far from establishing a prima facie case of obviousness for claims 36 - 70, the cited combination of references in the 1 July 2005 Office Action provides additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious. It does this by calling for a combination of references when the cited references teaches away from their proposed combination, by advocating a combination of references that is an almost certain failure and by relying on a combination of references that fails to suggest almost all of the claim limitations.

Another way the combination of references cited in the 1 July 2005 Office Action fails to establish a prima facie case of obviousness for claims 36 - 70 is that it fails to make the invention as a whole obvious as required by MPEP § 2141.02 which states that:

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious but whether the claimed invention as a whole would have been obvious.

As noted previously, the obviousness rejections are based on a combination of Marshall and Tull Jr.. Marshall and Tull Jr. both teach away from the method of the instant

application in a number of ways. As noted previously, the two references also teach away from their own combination. Taken together the cited combination of references fails to make the invention as a whole obvious. The cited combination also fails to make a single aspect of the claimed invention obvious. These failures provide additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious.

The fourth way the 1 July 2005 office action fails to establish a prima facie case of obviousness is that it does not teach how a system for portfolio management and a virtual reality system could be combined to produce anything useful. It is well established that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" (In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). In spite of this well know requirement, the office action has not described how the teachings of these references would be combined or the reason for doing so. The references documenting the state of the art for cross referenced applications teach away from the proposed combination. Furthermore, as detailed above, the reference teachings make it obvious that there are a number of reasons that the cited combination should not be made and that once made it could not reasonably be expected to produce anything useful.

The Assignee notes again that there are still other ways in which all §103 obviousness rejections in the 1 July 2005 Office Action for claims 36 – 70 can be traversed.

**Request for reference(s)**

On December 2002 and September 2004 notices of allowability provided by the Examiner of the instant application were withdrawn from cross-referenced application 10/097,344. The Assignee presumes that, in keeping with established procedures, the withdrawal of these notices of allowability were supported by one or more references. Accordingly, the Assignee hereby requests that any reference or references used to support a withdrawal of a notice of allowance for 10/097,344 be added to the official (written) record for the instant application so that they may be addressed in a subsequent office action and/or appeal.

**Reservation of rights**

The Assignee hereby explicitly reserves the right to present the modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

**Conclusion**

The Assignee respectfully requests consideration of the above referenced application as amended herein.

Respectfully submitted,

/BJ Bennett/

B.J. Bennett, President Asset Trust, Inc.  
Date: October 15, 2005